

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 5/26/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

3. Figures #1-2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The Drawings should be labeled for each of the entities in compliance with 37 CFR 1.121(d) is required.

Specification

4. The disclosure is objected to because of the following informalities: The specification need the sub-headings such as the Field of the Invention, Back Ground of Invention, Summary of the Invention, Brief Description of the Drawings, Detailed Description of the Embodiments or Invention etc.

Appropriate correction is required.

Claim Objections

5. Claims 2-14, 16-28, and 33 are objected to because of the following informalities: For example: Claim 2 (original) “**A** subscriber identity module according to claim 1,.....”

Dependent claims should change to “**the** subscriber identity module according to claim 1,.....”

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows:

Claims 31 and 35 are directed to *“a signal including an application”* with functional descriptive material. While functional descriptive material may be claimed as a statutory product (i.e., a “manufacture”) when embodied on a tangible computer readable medium, a “signal” per se does not fall within any of the four statutory classes of 35 U.S.C. §101. A “signal” is not a process because it is not a series of steps per se. Furthermore, a “signal” is not a “machine”, “composition of matter” or a “manufacture” because these statutory classes “relate to structural entities and can be grouped as ‘product’ claims in order to contrast them with process claims.” (1 D. Chisum, Patents § 1.02 (1994)). Machines, manufactures and compositions of matter are embodied by physical structures or material, whereas a “signal” has neither a physical structure nor a tangible material. That is, a “signal” is not a “machine” because it has no physical structure, and does not perform any useful, concrete and tangible result. Likewise, a “signal” is not a “composition of matter” because it is not “matter”, but rather a form of energy. Finally, a “signal” is not a “manufacture” because all traditional definitions of a “manufacture” have required some form of physical structure, which a claimed signal does not have.

A “manufacture” is defined as “the production of articles for use from raw materials or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931)).

Therefore, a “signal” is considered non-statutory because it is a form of energy, in the absence of any physical structure or tangible material, that does not fall within any of the four statutory classes of 35 U.S.C. §101.

NOTE: Refer to Annex IV, section (c) of the USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”, Official Gazette notice of 22 November 2005 (currently at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>).

Claim Rejections - 35 USC § 102

6.. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-30, 32-33, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Hind (US 2005/0037755).

Regarding claims 1, 15, 29-30, and 32, Hind teaches a subscriber identity module [0007] for use in mobile communications networks (GSM [0006]), said subscriber identity module storing a list of preferred mobile communications networks [0007], other than the home mobile network [0008-0014, 0028, 0043-0045], to be selected for providing services [0008-0014], and said subscriber identity module [0006]

being adapted to modify said list of preferred networks based on location information [0008-0014], [0023-0029], also paragraphs [0062-0066].

Regarding claims 2 and 16, Hind teaches a subscriber identity module according to claim 1, wherein said list is modified by an applet running on the subscriber identity module (Application and/or protocol [0014, 0036-0037]).

Regarding claims 3 and 17, Hind teaches a subscriber identity module according to claim 1, wherein said location information is obtained from the elementary file location information stored on the subscriber identity module (memory stored [0007-0014]).

Regarding claims 4 and 18, Hind teaches a subscriber identity module according to claim 1, further adapted to initiate action which may lead to the modification of said list of preferred networks in response to the location information elementary file being updated [0061-0064].

Regarding claims 5 and 19, Hind teaches a subscriber identity module according to claim 1, wherein said location information includes a country code [0049-0050].

Regarding claims 6 and 20, Hind teaches a subscriber identity module according to claim 1, further adapted to determine the country in which the subscriber identity module is being used [0013, 0014, 0024-0025].

Regarding claims 7 and 21, Hind teaches a subscriber identity module according to claim 1, further adapted to modify said list after it is determined that the

subscriber identity module is being used in a country different from the country where it was last used [0013-0014, 0024-0025, 0061-0066].

Regarding claims 8 and 22, Hind teaches a subscriber identity module according to claim 1, further adapted to select a network from said list which provides services in the country in which the subscriber identity module is currently being used [0008, 0024-0025].

Regarding claims 9 and 23, Hind teaches a subscriber identity module according to claim 8, further adapted to increase the priority of the selected network in the list of preferred networks [0013-0014, 0023-0025].

Regarding claims 10 and 24, Hind teaches a subscriber identity module according to claim 8, further adapted to swap the code of the selected network with the code at the first position of the preferred network list [0049-0050].

Regarding claims 11 and 25, Hind teaches a subscriber identity module according to claim 1, further adapted to cause the mobile terminal connected to the subscriber identity module to use the modified list of preferred networks [0013-0014, 0023-0025].

Regarding claims 12 and 26, Hind teaches a subscriber identity module according to claim 1, further adapted to initiate a refresh command of the file containing the preferred network list [0062-0064].

Regarding claims 13 and 27, Hind teaches a subscriber identity module according to claim 1, further adapted to prompt the user to cause the mobile terminal

connected to the subscriber identity module to use the modified list of preferred networks [0062-0064].

Regarding claims 14 and 28, Hind teaches a subscriber identity module according to claim 1, further adapted to prompt the user to switch the mobile terminal off and on to cause the mobile terminal connected to the subscriber identity module to use the modified list of preferred networks [0062-0064].

Regarding claim 33, Hind teaches a mobile terminal according to claim 32, wherein the priority of the selected network in the list of preferred networks is increased [0013-0014, 0023-0025, 0055-0056], such that the mobile terminal connected to the subscriber identity module reads the code of the selected network when the mobile terminal is selecting a network for providing roaming services [0049-0050].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. VU whose telephone number is (571)272-8131. The examiner can normally be reached on 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles N. Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Vu/
Examiner
AU-2617

/Charles N. Appiah/

Supervisory Patent Examiner, Art Unit 2617